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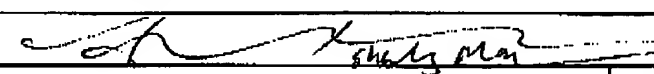
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shalong, Maa

Application No.: 09/919,187

Filing Date: 07-30-2001

Confirmation No.: 2621

Art Unit: 3623

Title: "Methods and systems for multimedia data synchronization and multilevel network communication"

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Dear Sir:

APPLICANT'S APPEAL BRIEF UNDER 37 C.F.R. § 41.37

With respect to the above-captioned patent Application, the undersigned Applicant respectfully appeals from the Examiner's decision of rejecting claims in the Final Office Action dated 10/05/2005 to the Board of Patent Appeals and Interferences as follows:

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PART I. REAL PARTY IN INTEREST

1. The real party in interest in the present case is Shalong Maa, Ph.D., the sole inventor and *pro se* Applicant of the Application.

PART II. RELATED APPEALS AND INTERFERENCES

2. None – There is no other appeal or interference known to Applicant that may be related to, or will directly affect or be directly affected by, or have a bearing on the Board's decision on the present Appeal.

PART III. STATUS OF CLAIMS

3. Applicant originally presented Claims 1-12 for consideration in the Application. Claims 1-12 were cancelled, without prejudice, and new Claims 13-32 were added in a Preliminary Amendment filed 09/03/2002. Thereafter, Claims 31-32 are cancelled, without prejudice, and new Claims 33-34 were added. Claims 13-30 and 33-34 stand rejected. Claims 16 and 24 are also objected to by the Examiner. The present Appeal is taken from the Examiner's rejections of Claims 13-30 and 33-34 in the Final Office Action.

PART IV. STATUS OF AMENDMENTS

4. No Amendments were filed subsequent to final rejection.

PART V. SUMMARY OF CLAIMED SUBJECT MATTER

5. The subject matters defined in the appealed claims 13-30 and 33-34 are summarized as follows:

Claim 13 is directed to a "handheld remote control device" {ref nos. 601 & 610 in Figs. 4-5} for control of a multimedia home entertainment system, which system includes an Internet-enabled home computer (204) {Lines 1-6 of ¶ [0034] on P11; ¶ [0039], [0040] on P14 of Spec}. The remote control device (601) includes a "bookmark key" {ref no. 615 in Fig. 5}. When a user press the bookmark key (615) of the remote control device, a web address or URL will be added to the bookmark URL listing of a web browser application running on the computer {Lns 4-6 of ¶ [0040] on P14, last 5 lines of ¶ [0041] on P15}. **The claim limitations set forth in Claim 13 include:** (1) a "web browser application" is executed by the home computer {Lns 4-6 of ¶ [0024] on P5; Ln 3 of ¶ [0034] on P11; Lns 3-5 of ¶ [0039] on P14; Ln 1 of ¶ [0041] on P14}; (2) the web browser application includes a conventional "bookmark function" for allowing the user to organize the URLs linking to the use's favorite web page {last 4 lines of ¶ [0041] on P15, Lns 4-7 of ¶ [0042] on P15}; and (3) the function of the bookmark key (615) of the remote control device (601) is to interact with

the web browser's bookmark URL listing {Line 4-6 of ¶ [0040] on P14; last 4 lines of ¶ [0041] on P15}.

Claims 14-15 provides further limitation to Claim 13 in that, the multimedia system therein includes a TV subsystem, the bookmarked URL is associated with a current TV program, and the remote control device (601) includes the conventional TV-control buttons {¶ [0034] on P11; Lns 9-13 of ¶ [0038] on P13; ¶¶ [0039]-[0041] on PP14-15}.

Claim 17 provides further limitation to Claim 13 in that, (i) the bookmarked web page therein is associated with a predetermined segment of a TV program, and (ii) the transmission of the TV program segment is in synchronization with the transmission of the bookmarked web page {Lns 2-4 of ¶ [0033] on P10; Lns 6-8 of ¶ [0034] on P11; ¶¶ [0035]-[0038] on pp11-14; Fig. 6}

Claim 18 is the method claim of Claim 13. It is drawn to a computer-implemented method of providing interactive content. The steps set forth in Claim 18 include (i) receiving a bookmark signal transmitted from the remote control device (601); and in response thereto, (ii) adding the web address or URL of a web page to the web browser's bookmark listing {Line 4-6 of ¶ [0040] on P14, last 5 lines of ¶ [0041] on P15}. The claim language of Claim 18 specifically includes a limitation that the foregoing steps are performed in response to a user's activation of a "single" bookmark button.

Claims 19-20 provides further limitation to Claim 18 in that the bookmarked URL therein is associated with a **current** TV program {Lns 9-16 of ¶ [0038] on PP13-14; ¶ [0034] on P11, ¶ [0039]-[0041] on PP14-15}.

Claim 21 provides further limitation to Claim 18 in that, the web content associated with the bookmarked URL is a data stream for control of a digital doll {Lns 5-9 of ¶ [0038] on P13}.

Claims 22-23 adds further steps to Claim 18, *i.e.*, receiving the web content by the client computer when the associated TV event is broadcasted and prior to the user pressing the bookmark key of the remote control for bookmarking such TV event {¶¶ [0035]-[0037] on PP11-13}.

Claims 24-26, 28 are also the method claim of Claim 13. Claim 24 is different from Claim 18 in that, (i) it particular set forth that the bookmarked web page is associated with a **current** TV event, and (ii) it includes the steps of requesting and receiving the web contents (not just the URL) in response to receiving the user's pressing of the Bookmark key of the remote control {¶ [0024] on PP5-6; Lns 4-6 of ¶ [0040] on P14; ¶¶ [0041]-[0042] on PP14-15}. Again, the claim language of Claim 24 also includes a specific limitation that the foregoing steps are performed in response to a user's activation of a "single" bookmark button.

Claim 27 provides further limitation to Claim 24 in that, the web content associated with the bookmarked URL is a data stream for control of a digital doll {Lns 5-9 of ¶ [0038] on P13}.

Claims 33 and 34 provides further limitation to Claims 13 and 18, respectively, in that the web content therein is a web page displayed on a display device. {¶¶[0024]-[0026] on PP5-6; ¶ [0038] on P13}.

PART VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

6. Applicant respectfully requests that the following Examiner's grounds of rejections be reviewed on the present Appeal:

- (a) Whether Claims 24-26 and 28 are anticipated by KELLY *et al.* under 35 U.S.C. §102(b);
- (b) Whether Claims 13-15, 18-20, 30 and 33-34 are unpatentable under 35 §103(a) over KELLY *et al.*
- (c) Whether Claims 17, 22, 23 and 29 are unpatentable under 35 §103(a) over KELLY *et al.* in view of PALMER *et al.*
- (d) Whether Claim 21 is unpatentable under 35 §103(a) over KELLY *et al.* in view of KIKINIS.
- (e) Whether Claim 27 is unpatentable under 35 §103(a) over KELLY *et al.* in view of KIKINIS and further in view of PALMER *et al.*

6a. **NOTE:** With respect to the foregoing ground of rejections, (i) The Examiner stated on page 10 in paragraph 10 of the Non-final Office Action dated 6/14/2005, "Claims 17, 22, 23 and 29 are rejected under 35 §103(a) as being unpatentable over Kelly *et al.* in view of Palmer *et al.*"; such a statement of ground of rejection, and the Examiner's **entire 3 pages of arguments** in support thereof (see paragraph 10, entire, on pages 10-13 of the 6/14/2005 Office Action), are **identical** to the Examiner's statement of ground of rejection of these Claims 17, 22, 23 and 29 and the entire arguments in supports thereof in the Final Office Action dated 10/05/2005 (See paragraph 10 on pages 14-16 of the 10/05/2005 Final Office Action); (ii) The Examiner stated on page 13 in paragraph 11 of the Non-final Office Action dated 6/14/2005, "Claim 21 is rejected under 35 §103(a) as being unpatentable over Kelly *et al.* in view of Kikinis"; such a statement of ground of rejection, and the Examiner's **entire arguments** in support thereof (see paragraph 11, entire, on pages 13 of the 6/14/2005 Office Action), are **identical** to the Examiner's statement of ground of rejections of Claim 21 and the entire arguments in supports thereof in the Final Office Action dated 10/05/2005 (See paragraph 11 on pages 16-17 of the 10/05/2005 Final Office Action). **HOWEVER**, with respect to the Examiner's obligation to respond to Applicant's arguments supporting Applicant's traverses, the Examiner stated on page 3 in paragraph 4 of the 10/05/2005 Final Office Action, "Applicant's arguments filed 8/12/2005 with respect to claims 13-23 have been **fully considered**, but there are considered moot in view of the **new grounds of rejection**."*[Emphasis added]*! But, again, with respect to Claims 17, 22, 23, 29 and Claim 21, there is **NO** new ground of rejection in the 10/05/2005 Final Office Action. **Applicant**

respectfully objects to the Examiners' such irresponsible manner in rendering the Office Actions.

PART VII. ARGUMENTS

7. Applicant's arguments in support of Applicant's traverses and of the present Appeal is as follows:

§ ONE. DIFFERENCES BETWEEN CLAIMED INVENTION AND PRIMARY REFERENCE

8. The key differences between the claimed invention and U.S. Patent No. 5,907,322 (KELLY, *et al.*) include:

- (a) **One step v. Two Steps**: As summarized in PART V above, in the claimed invention, the remote control device only include a single bookmark key, and the action of bookmarking a web content only include **ONE step**, *i.e.*, by pressing a single bookmark key of the remote control device. (The claim limitation of "single bookmark button" in Claims 18 and 24). **IN CONTRAST**, in KELLY *et al.*, the remote control device therein includes **TWO** buttons relating to such a bookmark action – (i) a "Bookmark" button, labeled as the "B" button (15) in the figures, and (ii) a network access "Go" button (16). Thus the entire process of obtaining a URL relating to a TV event therein comprises **two or more steps**. In the preferred embodiment of KELLEY *et al.*, such a process includes **two steps**, including (a) activating the "B" button 15, and thereafter, (b) activating the "Go" 16 button *at a later time* (see below). In its alternative embodiment of FIGS. 4-5, such a process includes an additional step of activating a download button 17 ("D").

See, in KELLEY *et al.*, (i) FIGS. 1-5; (ii) Col. 2, Lns 54-55 ("...select button 15 is labeled 'B' on remote control 12 to denote 'Bookmark'"); (ii) Col 3 Ln 52–Col 4 Ln 2 ("In the preferred embodiment, remote control 12 comprises a network access button 16 that... network button 16 is labeled 'Go' to denote 'Go to selected site'. Each time the viewer activates network button 16, a request to view a particular website is initiated ... it also provides the traditional operations of other conventional remote controls along with the event marking function buttons, such as provided by event selection button 15, (labeled here, for example, as 'B' for 'Bookmarking'), network access button 16 (labeled 'Go'), and in an alternative embodiment shown in FIG. 5, further described below, download button 17 (labeled 'D') and upload button (labeled 'U')" [*Emphasis added*]); (iii) See also Col 5, Lns 8-10; and Col 5 Ln 56—Col 6 Ln 2;

- (b) **URL v. AR/AT**: In the claimed invention, the client system's response to the user's pressing of the bookmark key of the remote control device is, either (i) saving a URL relating to a web content into the web browser's bookmark URL listing, or (ii) sending the URL to a designated web site such that the web site will, based on such URL received from the client, return the web content associated with the current TV event and identified by such URL to the client computer.

IN CONTRAST, in KELLY *et al.*, the client system's response to the user's pressing of the "B" button (15) of the remote control device is to cause an AR (activity record) entry, which is **not** and does not contain a URL or web page, to be saved or stored, in form of an AT (204) (activity table), into a local memory device; The system's response to the user's pressing of the "Go" button (16), which is *NOT* the same as the "B" button (15), is to cause to the AT (204), which is **not** and does not contain any URL, to be sent to the online database system (40).

See, in KELLEY *et al.*, (i) Col. 2, Lns 55-65 ("Each time the viewer activates select button 15 to bookmark a particular broadcast event, an activity record (AR) entry comprises data describing the date, time and channel is stored into an electronic memory 202 We refer to a list of AR entries as an activity table (AT) 204 that is stored in electronic memory 202." [*Emphasis added*]); (ii) Col. 3, Lns 17-19 ("For example, one of the AR entries in the AT might be (Sep. 1, 1996-19:30:32-CH7), indicating the date, time, and channel selected"); and (iii) Col 4, Lns 43-47 ("When the viewer wants to access the various websites associated with the selected broadcast events, the viewer activates network access button 16 ("Go") which causes peripheral device 21 to send the selected AT 204 to database 40 ..."); (iv) See also Col. 1, Lns 54-58; Col. 3, Lns 40-44; Col 4, Lns 8-19; and Col 5, Lns 39-52;

- (c) Current v. Later Time: in the claimed invention (Claims 14, 19, 24), the claim language is clear about the relation between the timing of the action of saving the URL or the timing of requesting the web page relating to a TV event and the timing of such TV event, *i.e.*, the TV event is a **Current** event. When the user sees an interesting TV event, the user will press the bookmark key of the remote control device; and in response thereto, the client system will immediately save the related URL of or immediately request from the designated web site the web content associated with the *currently interested* TV event;

IN CONTRAST, in KELLEY *et al.*, the activation of the network access button "Go" (16) is performed **at a later time**. Again, in KELLEY *et al.*, the process of obtaining a URL or web content relating to a TV event comprises **two or more steps** (See (a) "One step v. Two Steps" above), and the activation of the network access "Go" button (16) is done **at a later time**. Therefore, in KELLEY *et al.*, the *timing of activating the "Go" button 16 is not related to the timing of any TV event*. Thus, the "Go" button (16) is not related to the technical concept of Book-marking a "**current TV event**" set forth in the Claim of the present Application.

See, in KELLEY *et al.*, (i) Col 2 Ln 66 – Col 3 Ln 11 ("Once the viewer has completed marking a selection of broadcast events, AT 204 is stored into a network access device 21.... When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of FIG. 4, transmits activity table 204 comprising the AR entries and also viewer identifying data... to a central database 40" [*Emphasis added*]); (ii) Col 3, Lns 40-44 ("When Bookmark button 15 is pressed, remote control 12 sends a wireless signal comprising a command to CPU 216 to store an AR entry into AT 204 inside network access device 21, thereby 'bookmarking' the broadcast event for later lookup." [*Emphasis added*]); (iii) Col. 2, Lns 41-43 ("In

effect, this provides means to "bookmark" a televised event, marking that event for later recall" [*Emphasis added*])

- (d) **Sending v. Receiving URL**: in the claimed step of "requesting web content"(Claim 24), after the user press the bookmark key of the remote control device, the URL relating to the current TV event is sent **from** the client computer to the designated web site for requesting and receiving therefrom the web content identified by such URL.

IN CONTRAST, in KELLEY *et al.*, after the viewer activate the "Go" button of the remote control device, the "network address of the selected websites" is transmitted **from** the remote online database (40) to the client device (21) [*i.e.*, **contrary** to the claimed process].

See, in KELLEY et al., (i) Col 4, Lns 43–48 ("When the viewer wants to access the various websites associated with the selected broadcast events, the viewer activates network access button 16 ('Go') which causes peripheral device 21 to send the selected AT 204 to database 40, whereupon database 40 will **return to network access device 21 the network address** of the selected websites." [*Emphasis added*]); and (ii) Col. 5, Ln 60 – Col. 6 Ln 1 ("When viewer activates network access button 16 ('Go'), personal computing device 20 transmits AT 204 to database 40; whereupon **in response, database 40 transmits to personal computing device 20 the network address** of the associated website correlating to viewer's selection. Personal computing device 20 will **then** process the network address to generate the selected website or website hotlinks for access by the viewer" [*Emphasis added*])

- (c) **Web Browser's Bookmark Listing v. AT**: the claimed invention pertains to interaction between a remote-control device and a conventional "web browser's bookmark URL listing", *i.e.*, after a user press the bookmark key of the remote control device, an URL is stored in such "web browser's bookmark URL listing".

IN CONTRAST, KELLEY *et al.* does not teach such an interaction between a remote-control device and a "web browser's bookmark URL listing". Again, as set forth above, in KELLEY *et al.*, the activation of the Bookmark" button (15) of the remote control will cause an AR, which is **not** and does not contain a URL or web page, to be saved or stored, in form of an AT. The activity table AT of KELLEY *et al.* is not the conventional bookmark URL listing of a conventional web browser. Moreover, it is **not customary** for the data structure of the type of AR/AT therein to be added into the conventional bookmark URL listing of a conventional web browser, because as it is well known, only a URL or web address are usually added into the bookmark URL listing of a conventional web browser.

See the foregoing (b) "URL v. AR/AT" and (d) "Sending v. Receiving URL".

- (f) **Previously v. Later Received Web Content**: In the claimed invention, with respect to the claim element of "bookmarking a web content/URL", the web content/URL is received by the client computer **prior to** (see Claims 22-23, 33-34, and 17) the user's action of pressing the Bookmark Key of the remote control device. In one embodiment (Claims 33-34), the web page is **already** "displayed on a display" **before** the user pressing the bookmark key. In another

embodiment (see Claims 17, 22-23), the web content or URL is transmitted to from the web site to the client computer "in synchronization" with the broadcasting of the TV event, which is **before** the user pressing the bookmark key for bookmarking such TV event.

IN CONTRAST, in *KELLEY et al.*, the "network address of the selected websites" is transmitted from the remote online database (40) to the client device (21) **after** the user's activation of the network access button "Go" (16) which is **further after** the user's the activation of the bookmark "B" button (15); *i.e.*, the user first press the "B" button (15), then press the "Go" button (16), **then thereafter**, the client system receive the web page or URL.

See the foregoing (a) "One step v. Two Steps", (b) "URL v. AR/AT", and (c) "Current v. Later Time", and (d) "Sending v. Receiving URL".

§ TWO. MODIFICATION OF REFERENCE TO ARRIVE AT CLAIMED INVENTION

9. In view of the foregoing differences between the claimed invention and *KELLY et al.*, many technical components therein need to be modified in order to arrive at the claimed invention. First of all, it is **not feasible to modify the second embodiment** in association with FIG. 4 therein to arrive at the claimed invention. Because in such embodiment, there is no direct interaction between the "B" button (15) of the remote control device (10) and the network access device (20); the entire system's response to the user's activation of the "B" button (15) of the remote control device (10) is to store the activity table AT **within the remote control device (10)**; then after the user activate a download button (17) of the device (10), the AT is transmitted from remote control device (10) to the personal computing device (20). Thus, in this embodiment, there is no wireless signal transmitted and thus no interaction between the remote control device (10) and the network access device (20) after the user activate the bookmark button "B" (15).

See, in KELLEY et al., (i) Col. 4 Lns 56-58 ("In this embodiment, AT 204 is first stored in a remote control device 10 and later downloaded from remote control 10 to a personal computing device 20") and (ii) Col. 5 Lns 56-60 ("When the viewer wants to access the various websites associated with the selected broadcast events, the viewer then activates download button 17 to transfer stored AT 204 to personal computing device 20 via the wireless interface 231 or the I/O interface 233.")

10. The modification of the **technical components** of the first embodiment of *KELLY et al.* in association with FIGS. 1-3 therein to arrive at the claimed invention shall be done as follows:

(a1) **Modification of client system** – As set forth in ¶ 8(e) of § ONE above, *KELLY et al.* does not teach interaction between a remote-control device and a "web browser's bookmark URL listing" as is claimed. In the embodiment of FIGS. 1-3 of *KELLY et al.*, the action of the CPU (216) of the network access device (21) in response to the wireless command signal from the remote control device is based on a custom command table (206); and such a client system need to be modified to arrive at the claimed invention such that, in response to receiving a wireless

signal associated with the "B" button (15) of the remote control device (12), the CPU will interact with the web browser's bookmark URL listing instead of "query real time clock ... and IR command table ... to generate AR". It is understood that, **using a remote control device to operate a web browser to surf the web and to interact with the browser's bookmark URL listing are not conventional ways of surfing the web, and is not taught in KELLY *et al.*** See, in KELLEY *et al.*, (i) Col. 3 Lns 35-44 ("CPU 216 controls among other functions, a wireless interface 230, a custom command table 206, communications with external devices via an I/O interface 232... When Bookmark button 15 is pressed, remote control 12 sends a wireless signal comprising a command to CPU 216 to store an AR entry into AT 204 inside network access device 21") (ii) Col. 4 Lns 8-13 ("In operation, whenever the viewer activates event selection button 15 'B' on keypad 14 (FIG. 3), this activation contemporaneously triggers CPU 216 (FIG. 2) in network access device 21 to concurrently query real time clock 220 for the current date and time, and IR command table 212 for the current channel, in order to generate an AR..."). In addition,

- (a2) **Receiving Web content / URL in advance** – As set forth in ¶¶ 8(b)-(d) and (f) of § ONE above, in KELLY *et al.*, the "network address of the selected websites" is transmitted from the remote online database (40) to the client device (21) after the user's activation of the network access button "Go" (16) which is further after the user's the activation of the bookmark "B" button (15); **Whereas**, in the claimed invention, the web content/URL is received by the client computer prior to the user's action of pressing the Bookmark Key of the remote control device. **Again, using a remote control device to operate a web browser and to surf the web is not a conventional way of surfing the web, and is not taught in KELLY *et al.*** Thus, in order to arrive at the claimed invention, in addition to the foregoing (a1) modification, the user's interested web content or the URL thereof (such as the one related to a TV event) has to be, somehow, transmitted to the client device before the user activating the "B" (15) or the "Go" (16) button such that such URL can be saved into the web browser's bookmark URL listing in response to activation of the "B" or "Go" button.

11. In addition to the foregoing, the following modifications of KELLY *et al.* are also needed to arrive at the claimed invention:

- (b) **Combining two buttons into one** – As set forth in ¶ 8(a) of § ONE above, in KELLY *et al.*, the remote control device therein includes two buttons relating the bookmark action, including the "B" button (15) and the "Go" button (16), and the action of bookmarking include at least two steps; **Whereas** in the claimed invention, the remote control device only include one bookmark key. In order to arrive at the claimed invention, the "B" button (15) and the "Go" button (16) of in KELLY *et al.* 's remote control device need to be combined into one button, and
- (c) **Changing data structure of AR/AT** – As set forth in ¶ 8(b) of § ONE above, In KELLY *et al.*, the client system's response to the user's pressing of the "B" button (15) of the remote control

device is to cause an AR (activity record) entry to be saved into an AT (activity table). The data structure of the AR/AT is completely different from that of a URL or IP web address. **Whereas**, in the claimed invention, the client system's response to the user's pressing of the bookmark key of the remote control device is to save a URL into the web browser's bookmark URL listing. In order to arrive at the claimed invention, the data structure of the AR/AT in KELLY *et al.* has to be, somehow, changed to that of a URL or a or IP web address.

However, in the Final Office Action, the Examiner failed to provide (i) adequate objective evidence of **suggestion or motivation** to perform the foregoing modification, nor (ii) any objective evidence of **reasonable expectation of success** in any attempt to perform the foregoing modification; Moreover, in many cases, the Examiner even failed to (iii) ascertain precisely how to modify which specific technical element of the references to arrive at the claimed invention. (See below)

§ THREE. REJECTION UNDER 35 U.S.C. §102(b) OVER KELLY *et al.*

12. Applicant respectfully traverses and appeals to the Board from the Examiner's rejections of Claims 24-26 and 28 as being anticipated by KELLY, *et al.* under 35 U.S.C. §102(b) as follows

13. **Examiner's Error in Rejection** – The Examiners' errors in the §102(b) rejections of Claims 24-26 and 28 in the Final Office Action include:

- (a) The Examiners failed to follow and have deliberately ignored Applicant's previous citation and discussion of **legal authorities**, including citations of legal precedents, as to the legal concept of anticipation, and did not provide any legal authorities in support of the Examiners' rejections;
- (b) The Examiners' response to Applicant's previous arguments were not pertinent to the rejections, because Claims 24-26 and 28 are method claims that include several critical performance steps; However, instead of discussing whether these critical steps were disclosed in KELLY, *et al.*, Examiners' response to Applicant's previous arguments were directed to "structural difference";
- (c) The Examiner failed to acknowledge the foregoing "Sending v. Receiving URL" and "URL v. AR/AT" differences between the claimed invention and KELLY, *et al.* (See ¶ 8 in § ONE above);
- (d) The Examiner did not properly address the foregoing "One step v. Two Steps" and "Current v. Later Time" differences between the claimed invention and KELLY, *et al.* (See ¶ 8 in § ONE above); and
- (e) The Examiner's rejection was NOT based on the teachings of the prior art, but rather on matters made up by the Examiner himself;
as hereinafter more fully appears.

14. **Legal Concept of § 102 Anticipation** – The legal concept of anticipation under § 102 is well established as that, (i) every claim element in the claim must be found in a single prior art reference, and that (ii) the claim elements found in the prior art reference must also be arranged as required by the claim. See, e.g., (A) *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” [emphasis added]); and (B) *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ...claim.” and “Every element of the claimed invention must be literally present, arranged as in the claim” [emphasis added]); See also MPEP § 2131. Moreover, evidence of secondary consideration, such as unexpected result or commercial success, and the issues of non-analog art and teaching away from claimed subject matter are not relevant to §102 rejections

§ 3.1 Claims 24-26 and 28

15. The claim limitations set forth in the following claim languages of Claim 24 are not found in *KELLEY et al.*:

“... method for providing interactive content associated with a **current TV event** ... comprising the steps of: In response to receiving an wireless bookmark signal... said wireless bookmark signal representative of said user's activation of a **single** bookmark button on said remote control device, **Requesting** a web content associated with said current TV event from a designated web site, ...”[emphasis added]

16. Such claim languages make it clear about (i) the timing of performing the critical step of “requesting a web content” – the timing of performing such a critical step is immediately after the occurrence of the associated TV event, i.e., the TV event is a “**current TV event**”. The Claim limitation of the term “**current**” requires that the critical step of “requesting” is for requesting a web content that is associated the current TV event being presented to the user; Such a step is performed immediately after the user press the “bookmark” button on the remote control device while watching the currently interested TV event; and (ii) the fact that the claimed steps are performed in response to the user's activation of a “**single**” bookmark button of the remote control device.

IN CONTRAST, (i) In *KELLEY et al.*, the activation of the network access button “Go” (16) is performed at a **later time** as compared with the timing of the related TV event. (See See ¶ 8(c) “Current v. Later Time” in § ONE above, which is incorporated herein by reference.); (ii) In *KELLEY et al.*, the function of the Bookmark or “B” button 15 is different from that of Claim 24 in that, it does not cause the system to perform the step of requesting information from a web site or interacting with the network; and (iii) In *KELLEY et al.*, the related bookmark actions involves **two or more buttons** on the remote control device (as opposed to a “**single**” button in Claim 24) (See See ¶ 8(a) “One step v. Two Steps”, ¶ 8(b) “URL v. AR/AT”, and ¶ 8(c) “Current v. Later Time” in § ONE above, which is incorporated herein by reference.)

17. Moreover, the claimed step of “Requesting a web content” is defined in paragraph [0024] of the specification as that, “In a standard request-response process for viewing a graphical Web page 334 by the client 100, the client system 100 specifies the URL or IP address of the Web page 334 in a request, which is forwarded to the corresponding Web server 332 supporting the Web page 334.” Thus, in the claimed invention, after the user presses the bookmark key of the remote control device, the URL relating to the current TV event is sent **from** the client computer to the designated web site for requesting and receiving therefrom the web content identified by such URL. **IN CONTRAST**, in *KELLEY et al.*, after the viewer activate the “Go” button of the remote control device, the “network address of the selected websites” is transmitted **from** the remote online database (40) to the client device (21) [*i.e.*, **contrary to the claimed process**] (See ¶ 8(d) “Sending v. Receiving URL” and ¶ 8(f) “Previously v. Later Received Web Content” in § ONE above, which is incorporated herein by reference.)

18. Therefore, (i) the critical step of Requesting a web content associated with the **current TV event** and (ii) the claim element of “wireless bookmark signal representative of said user’s activation of a **single bookmark**” set forth in Claim 24 are **not** taught in *KELLEY et al.* The Examiners failed to meet the foregoing requirement that, (i) every claim element in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California, Supra*; and that, (ii) the identical invention must be shown in as complete detail as is set forth in the claim. *Richardson v. Suzuki Motor Co., supra*.

19. The Examiner stated on page 3 of the Final Office Action, “The examiner acknowledges the fact that Kelly et al. discloses the process of obtaining a URL relating to a TV event as comprising two or more steps; however, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art” and “the examiner notes that if a user bookmarks a TV event and activates the ‘Go’ button soon thereafter, the user performs the function of bookmarking a ‘current TV event’ if performed before a television event (a program, for example) has ended ” Applicant’s response to the Examiner’s such arguments is as follows:

- (a) First of all, Claim 24 is a method claim! and the issue should be about whether each step set forth in Claim 24 is identical to any step or process disclosed in the prior art reference, not about “structural difference”. Applicant respectfully objects to the Examiners’ such irresponsible manner in rendering the Final Office Action.
- (b) Claim 24 is directed to a “computer-implemented” method, not a process of human action.
- (c) The Examiner’s foregoing statement on which the rejections are based is **NOT** pertinent to the teachings of the prior art reference, but is rather the matters provided by the Examiner himself; Such a teaching of “user bookmarks a TV event and activates the ‘Go’ button soon thereafter ... before

a television event ... has ended" is not found in KELLEY et al. To the contrary, KELLEY et al. expressly teaches that the bookmarked TV event is intended for "later lookup" (see above).

Again, the key issues are (i), what is *exactly* taught in the prior art (i.e., not including the matter made up by the examiner) as compared with what is set forth in the Appealed claims, and (ii) whether authorities such as legal precedents set forth above should be applied.

§ FOUR. REJECTION UNDER 35 U.S.C. §103(a) OVER KELLY et al.

20. Applicant respectfully traverses and appeals to the Board from the Examiner's rejections of Claims 13-15, 18-20, 30, and 33-34 as being un-patentable over KELLY, et al. under 35 U.S.C. §103(a) as follows:

21. **Legal Concept of Obviousness Under §103**– The legal concept of obviousness under § 103 is well established as that,

- (A) In order to rely on reference(s) for obviousness rejection under 35 U.S.C. §103, **all claim limitations** of Applicant's Claim must be taught or suggested by the reference(s); See MPEP §§ 2142, 2143.03; See also *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); and *In re Royka*, 490 F.2d 981 (CCPA 1974);
- (B) There must be a **reasonable expectation of success** in attempt to modify or combine reference(s). *In re Rinehart*, 531 F.2d 1048, 1053-1054 (CCPA 1976) ("The tribunals below did not meet the requirement of establishing some predictability of success in any attempt to combine elements of the reference processes..."), See also *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); MPEP § 2143.02.
- (C)* There must be some **suggestion or motivation** to modify or combine the prior art references, and the suggestion to modify or combine and reasonable expectation of success **must be founded in the prior art**, and not based on Applicant's disclosure. See e.g., *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) ("... a proper analysis under § 103 requires, *inter alia*, consideration of two factors ... Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." [*Emphasis added*]); See also MPEP § 2142-43 and many other court decisions cited in MPEP §§ 2142-44. Said suggestion or motivation or rationale to modify may be expressly or impliedly contained in the prior art; Otherwise, Examiner must provide other **objective evidence** as to why the prior art would render obvious the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); and MPEP § 2142;
- (D) Moreover, where the suggestion to modify cannot be found in any prior art references, Examiner **may not rely on level of skill** in the art to provide such suggestion. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999) ("Rarely, however, will the skill in the art

component operate to supply missing knowledge or prior art to reach an obviousness judgment”) See also § MPEP 2143.01. But rather, the Examiner’s rejection must be based on some **specific understanding**, such as scientific or technology principle, within the knowledge of one of ordinary skill. See, e.g., *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (“Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate... the examiner selected these references with the assistance of hindsight.” [*Emphasis added*]); *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated ... we conclude that the Board did not make out a proper *prima facie* case of obviousness” [*Emphasis added*]); etc.; See also § MPEP 2143.01;

- (E) Furthermore, the fact that the references can be modified or that the claimed invention is within the **capability** of one of ordinary skill in the art is **not** sufficient to establish *prima facie* obviousness **unless** prior art suggested desirability of modification. See *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990) (“While Mathis apparatus [prior art] may be capable of being modified to the run the way the Mills’ apparatus is claimed, there must be a suggestion or motivation in the reference to do so” [*Emphasis added*]); See also *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993); *In re Kotzab*, *supra*; § MPEP 2143.01;
- (F) When the suggestion to modify a reference cannot be found in any prior art references, such suggestion or motivation must be based on some other **objective teachings** or **evidence**, and **NOT on conclusory statements**. See also *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (PTO can satisfy the burden to establish a *prima facie* case of obviousness “only by showing some objective teaching ...” [*Emphasis added*]); *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation ... that one of ordinary skill in the herbicidal art would have been motivated to make the modification...”); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) (“The factual inquiry whether to combine references must ... be based on objective evidence of record”, 277 F.3d at 1343, and “The board cannot rely on conclusory statements when dealing with particular combinations of prior art...” 277 F.3d at 1345 [*Emphasis added*]).
- (G) The **Examiners cannot simply render argument or conclusion based on their own understanding or experience**. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (“The Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings” [*Emphasis added*])

22. **Examiner’s Error in Rejection** – The Examiners’ errors in their §103 rejections are readily apparent in view of the foregoing legal concept of obviousness under 35 U.S.C. § 103. In particular, in these rejections in the Final Office Action,

- (a) The Examiner failed to applied the standard set out by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In particular, the Examiner failed to properly **ascertain the differences** between the claimed invention and the primary reference, KELLEY *et al.*, as set forth in ¶ 8 of § ONE above;
- (b) In many cases, the Examiner only stated that the references CAN be modified to arrive at the claimed invention, but failed to even state how to modify the reference(s) and *which specific technical components* of the reference(s) is to be modified to arrive at the claimed invention;
- (c) Because of (b), the Examiners' arguments in support of the rejections are mere conclusory statements;
- (d) With respect to the Examiner's proposed modification and/or combination of the prior art references, the Examiner failed to provide **objective evidences of suggestion or motivation to combine / modify the references** and of **reasonable expectation of success** in attempt to perform the modification;
- (e) The Examiners did not provide any legal authority in support of the rejections, and failed to follow and have deliberately **ignored** Applicant's previous citation and discussion of **legal authorities**, including citations of legal precedents, relating to the legal concept of anticipation obviousness under § 103.

as hereinafter more fully appears.

§ 4.1. Claims 13, 15, 18, and 30

23. The Examiner stated in the Final Office Action, (i) on page 9, "Kelly et al. does not specifically disclose that the bookmark key causes a web browser to add a bookmark linking to a web content identified by a URL to the bookmark URL listing of the browser in response to the user's activation of bookmark key;" (ii) on page 11 and 12, "Kelly et al. does not specifically disclose ... adding a bookmark linking to a web content identified by a URL to the web browser's bookmark URL listing;" and (iii) on pages 9, 11, 12, "however, Kelly et al. was aware of pull-down bookmark menus existing in typical net browsers (col. 1, l.34-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Kelly et al. to add a bookmark linking to a web content identified by a URL to the bookmark URL listing of a browser in response to pressing a bookmark key in order to provide a user-friendly, automated system to "bookmark" TV broadcast events and the URLs associated with these events for subsequent viewer use (col. 1, l.41-45)."

24. The Examiner failed to establish *prima facie* case of obviousness in rejecting Claims 13, 15, 18, and 30 because:

- (a) The Examiner failed to ascertain the foregoing "Sending v. Receiving URL" and "Previously v. Later Received Web Content" differences set forth in ¶¶ 8 (d) and (f), respectively, of § ONE above, which is incorporated herein by reference. *Graham v. John Deere, supra*.

- (b) Because of (a), the proposed modification by the Examiner is **not functional feasible**. As set forth in ¶ 8(f) of § ONE above, at the time when the user press the “B”(15) and/or the “Go” (16) button, the user’s interested web content and/or the URL has NOT yet been received by the client system of KELLY, *et al.* Thus, it would be impossible to “add a bookmark linking to a web content identified by a URL to the bookmark URL listing of a browser in response to pressing a bookmark key” when such a URL bookmark does not yet exist when the user “pressing a bookmark key” Therefore, there is **NO reasonable expectation of success** in the Examiner’s attempt to modify KELLY, *et al.* *In re Rinehart, supra; In re Vaeck, supra.*
- (c) Using a remote-control device to control a web browser and to surf the web is NOT a conventional way of surfing the web. Such remote-control based web surfing action by a user is NOT taught in KELLY, *et al.* Thus, according to the teachings of KELLY, *et al.*, the ONLY way for any web page or URL to be transmitted to the client system of KELLY, et al. is after the user pressing the “Go” button (16). Thus, again, it would not be feasible to “add a bookmark ... URL to the bookmark URL listing of a browser in response to pressing a bookmark key” when such a bookmark URL does not exist. Therefore, again, there is **NO reasonable expectation of success** in the Examiner’s alleged modification of KELLY, *et al.* *In re Rinehart, supra; In re Vaeck, supra.*
- (d) The Examiner’s foregoing statement of “it would have been obvious ... to modify Kelly et al. to add a bookmark ...” is merely a statement that KELLY, *et al.* can be modified to arrive at the final results of the claimed invention, which is not sufficient. *In re Mills, Supra. In re Fritch, Supra. Ex parte Levengood, Supra. In re Kotzab, supra.* The Examiners failed to specify precisely which technical components of KELLY, *et al.* is to be modified to arrive at the claimed invention. In particular, the Examiner failed to acknowledge the foregoing “Modification of client system” and “Receiving Web content / URL in advance” set forth in ¶¶ 10 (a1) and (a2), respectively, of § TWO above, which are incorporated herein by reference. Moreover, there is **no objective evidence of suggestion or motivation** to make the foregoing modification of “Modification of client system” and “Receiving Web content / URL in advance”. *Ex parte Clapp, supra; In re Vaeck, supra; In re Lee, supra; In re Rouffet, supra; In re Kotzab.*
- (e) Because of (d), the Examiners’ foregoing statements in support of the rejections of Claims 13, 15, 18, and 30 are mere **conclusory statements and the Examiners’ own speculation**, which are not sufficient to establish *prima facie* case of obviousness. *In re Lee, supra. In re Jones, supra.*
- (f) The Examiner’s foregoing statement of “it would have been obvious ... in order to provide a user-friendly, automated system to “bookmark” TV broadcast events and the URLs associated with these events for subsequent viewer use (col. 1, 1.41-45)” is a quotation of KELLY, *et al.*’s statement of general objective of the KELLY, *et al.*’s entire invention, and is found in the “Background” section therein. Any two inventions of the same field could have very similar objective (such as

“to provide a user-friendly, automated system”). The issue is not whether the two inventions has the same or similar objectives, but rather, whether there is objective evidence of suggestion or motivation to make the foregoing modifications of the **specific technical components** of the prior art references to arrive at the claimed invention. KELLY, et al. does not teach anything relating to the foregoing modification (See (d)), and it would be irrational to find in KELLY, et al. any motivation for suggesting such modification.

§ 4.2. Claims 18-19

25. In rejecting Claims 18-19, the Examiner failed to establish *prima facie* case of obviousness, because, in addition to § 4.1. above, the Examiner failed to ascertain the foregoing “One Step v. Two Steps” difference set forth in ¶ 8(a) of § ONE above, which is incorporated herein by reference. *Graham v. John Deere, supra*. In addition to the modification set forth in § 4.1., the foregoing modification of “Combining two buttons into one” set forth in ¶ 11(b) of § TWO above has to be performed to arrive at the claimed invention, because the claim language of Claim 18 specifically include a limitation of “activating a single bookmark button on said remote control device”, whereas, in KELLY *et al.*, the remote control device therein includes two buttons relating the bookmark action, including the “B” button (15) and the “Go” button (16). See ¶ 11(b) of § TWO above, which is incorporated herein by reference. There is **no objective evidence of suggestion or motivation** to make the foregoing modification of “Combining two buttons into one”. *Ex parte Clapp, supra; In re Vaeck, supra; In re Lee, supra; In re Rouffet, supra; In re Kotzab.*

§ 4.3. Claims 14 and 19

26. In rejecting Claims 14 and 19, the Examiners stated in the Final Office Action, on page 10 and 11, “...in the system of Kelly et al., the user can press the ‘Go’ button at any time subsequent to pressing the bookmark button. If the user were to press the ‘Go’ button directly after pressing the bookmark button, the retrieved list of network address would be associated with the current TV event”.

27. The Examiner failed to establish *prima facie* case of obviousness in rejecting Claims 14 and 19 because, the foregoing Examiner’s statement is NOT found in any of the prior art references, but rather, it is the examiner’s own statement. In fact, as set forth in “Current v. Later Time” in ¶ 8(c) of § ONE above, which is incorporated herein by reference, in KELLEY *et al.*, the activation of the network access button “Go” (16) is performed at a later time. Thus, KELLEY *et al.*, teaches away from the claim invention. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983).

§ 4.4 Claims 20, 33, 34

28. The Examiner failed to establish *prima facie* case of obviousness in rejecting Claims 20, 33, and 34, because (i) Examiner failed to ascertain the foregoing “Sending v. Receiving URI” and

“Previously v. Later Received Web Content” differences set forth in ¶¶ 8 (d) and (f), respectively, of § ONE above, which is incorporated herein by reference. *Graham v. John Deere, supra.*; (ii) The Examiner failed to state how to modify KELLY *et al.* to arrive at the claimed invention. See § TWO above; thus, (iii) The Examiner’s rejections was based on impermissible conclusory statements. *In re Lee, supra. In re Jones, supra.*

§ FIVE. REJECTION UNDER 35 U.S.C. §103(a) OVER KELLY *et al.* in VIEW of PALMER *et al.*

29. Applicant respectfully traverses and appeals to the Board from the Examiner’s rejections of Claims 17, 22-23, and 29 as being un-patentable over KELLY, *et al.* in view of PALMER *et al.* under 35 U.S.C. §103(a) as follows.

§ 5.1 Claims 17, 22-23, 29

30. First of all, in the Final Office Action, the Examiners failed to respond to Applicant’s previous arguments (See paragraph 6a in PART VI above). In the Final Office Action, the Examiners acknowledged certain differences between the claimed invention and KELLY, *et al.*, and stated therein, (i) on page 14 (Claim 17), “Kelly *et al.* does not disclose that the web content is associated with a predetermined segment of a TV program. Kelly *et al.* also does not disclose that the transmission of the web content from the web site to the web browser is in synchronization with the broadcasting of a predetermined segment of TV program”; (ii) on page 14-15 (Claim 22), “Kelly *et al.* does not disclose that the web content being transmitted from the web site to the computer is transmitted in synchronization with the broadcasting of a TV program”; and (iii) on pages 15-16 (Claim 29), “Kelly *et al.* does not teach the step of retrieving the URL associated with the web content prior to the step of sending the request.”

31. With respect to the pertinent teachings in PALMER *et al.*, the Examiners stated in the Final Office Action, (i) on page 14 (Claim 17) and page 15 (Claim 22), “Palmer *et al.* discloses a method and apparatus for connecting a computer to electronic address in sync with an audio/video broadcast [(col. 5, 1.22-34)]. The radio and television stations provide a central office 70 with a schedule of programming and the associated URL’s. In accordance with those schedules, the central offices sends page requests via Internet at predetermined times (col. 5, 1.45-50)”; and (ii) on pages 15-16 (Claim 29), “Palmer *et al.* discloses a general computer 40 with a program that continuously monitors and/or polls receiver 30 to determine whether any pages have been received. When a page has been detected as received, the program tests the page to determine whether it includes a valid URL. If the message is a valid URL, the program stores the URL in memory. The processor 44 then causes modem 50 to connect computer 40 with an Internet Service Provider 60. The program sends the stored URL to Internet Service Provider 60 which allows computer 40 to receive information from and interact with the web site associated with the URL”.

32. With respect to the combination of the two references, the Examiner stated, (i) on page 14 (Claim 17) and page 15 (Claim 22), “It would have been obvious to anyone of ordinary skill in [the] art at

the time that the invention was made to modify Kelly et al. to include URL messages that are associated with television programming at a predetermined time and sent in sync with one another to the user's television 82 and computer 40 in order to allow the synchronous display of Internet content that is associated with broadcasting content (col. 1, 1.50-57)."; and (ii) on page 16 (Claim 29), "It would have been obvious to modify Kelly et al. to include a system of sending URLs to personal computing device 20 in advance of accessing a web site such as that taught by Palmer et al. in order to decrease the processing time of a web site access request (col. 1, 1.50-57)."

33. However, the specific matters that is missing from the Examiners statements in support of rejection of Claims 17, 22-23 and 29 is, the **suggestion or motivation to modify and combine KELLY, et al. and PALMER et al.** as proposed by the Examiner; In fact, no such suggestion or motivation can be found in any of the prior art references, and there is no other **objective evidence** thereof. Therefore, the Examiners failed to establish *prima facie* case of obviousness. *Ex parte Clapp, supra; In re Vaack, supra; In re Lee, supra; In re Kotzab.* The Examiners' selection of the secondary reference in rejections of Claims 17, 22-23 and 29 are based on impermissible hindsight. *In re Rouffet, supra.* With respect to the foregoing Examiner's statement relating to the teaching in col. 1, 1.50-57 of PALMER et al. in rejecting Claim 29, again, the Examiner were using the objective of PALMER et al.'s entire invention as the rationale for supporting the alleged combination. Such an objective shall only results in the invention therein, **not the combination, because PALMER et al. does not teach any matter relating to a remote-control based TV system, nor how to combine.**

34. Moreover, the synchronization system of PALMER et al. pertains to an "alpha-numeric" paging system, which is completely different from that of the claimed invention. See PALMER et al., Col 4, Ln 1-4: "Receiver 30 is connected to processor unit 44 via cable 31. Receiver 30 is preferably an alpha-numeric pager/beeper unit, which is capable of receiving alpha-numeric information via a page"[*Emphasis added*]). Thus, the Examiner failed to meet the foregoing requirement that, **all** claim limitations of Applicant's claim must be taught or suggested by the references. *In re Wilson, supra.*

§ SIX. REJECTION UNDER 35 U.S.C. §103(a) OVER KELLY et al. in VIEW of KIKINIS

35. Applicant respectfully traverses and appeals to the Board from the Examiner's rejections of Claim 21 as being un-patentable over KELLY, et al. in view of KIKINIS under 35 U.S.C. §103(a) as follows.

§ 6.1 Claim 21

36. First of all, in the Final Office Action, the Examiners failed to respond to Applicant's previous arguments (See paragraph 6a in **PART VI** above). In the Final Office Action, (i) the Examiners acknowledged certain differences between the claimed invention and KELLY, et al., and

stated on page 16 therein, “Kelly et al. does not disclose that the web content includes a stream of actuation-control data for controlling body part movement of an Internet-enabled talking doll coupled to and controlled by a multimedia computer”; (ii) with respect to the pertinent teaching in KIKINIS, the Examiner stated on page 16 therein, “Kikinis discloses an interactive doll system 11 comprising a doll 13 adapted for bi-directional communication with a PC 15 (col. 5, l.17-19)(Fig. 1). By way of peripheral connection, doll 13 acquires all of the computing and data power of the host. The host has an appropriate telephone modem and Internet operative software, giving the doll access to data and routines available on the Internet (col. 5, l.32-34)(col. 7, l.19-24)(col. 9, l.20-25). The doll has controllable moving body parts and speech functions (col. 5, l.56-67 and col. 6, l. 1-11)(Fig. 1)”; (iii) With respect to the alleged combination of the two references to arrive at the claimed invention, the Examiner stated on page 17, “It would have been obvious to anyone of ordinary skill in the art at the time the inventions was made to modify Kelly et al. to include web content including control routines and data for body part movement and speech functions of a doll 13 coupled to personal computing device 20 such as that taught by Kikinis in order to portray broadcasting related content interactively through a computer controlled doll (col. 2, l. 35-45)” [*emphasis added*].

37. However, (I) with respect to the Examiner’s foregoing statement of “in order to portray broadcasting related content interactively through a computer controlled doll”, technical wise, Applicant is not aware of how such a statement is related to Claim 21, because in Claim 21, there is NO claim language or claim limitation of “broadcasting related content” as stated by the Examiner, (II) the claim language / limitation of Claim 21 include “said web content includes a stream of actuation-control data for controlling body part movement of an Internet-enabled talking doll”, which means the “actuation-control data” for control of the doll is transmitted to the client through the Internet; whereas KIKINIS only teaches that the doll-control data are sent from the client computer to the doll, as acknowledged by the Examiners; But, KIKINIS does **not** teaches that the doll-control data is transmitted from the web; Such an claim elements of doll-control data being received by the client system from the Internet is not found in KIKINIS nor in KELLY, *et al.* As acknowledged by the Examiners in the foregoing Examiners’ statement of “Kelly et al. does not disclose that the web content includes a stream of actuation-control data for controlling body part movement of an Internet-enabled talking doll coupled to and controlled by a multimedia computer”. But the Examiner failed to realize that, KIKINIS **does not** disclose that “the web content includes a stream of actuation-control data for controlling body part movement of an Internet-enabled talking doll coupled to and controlled by a multimedia computer” **either**. The Examiners failed to meet the foregoing requirement that **all claim limitations** of Applicant’s Claim must be taught or suggested by the references. *In re Wilson, supra. In re Royka, supra.* (III) Moreover, there is no **suggestion or motivation** to modify and combine KELLY, *et al.* and KIKINIS as alleged by the Examiners. *Ex parte Clapp, supra; In re Vaeck, supra; In re Lee, supra; In re Kotzab.* (IV) The Examiners’ rejections are based on the Examiners’ conclusory statements. *In re Lee, supra.*

§ SEVEN. REJECTION UNDER 35 U.S.C. §103(a) OVER KELLY *et al.* in VIEW of KIKINIS and FURTHER in VIEW of PALMER *et al.*

38. Applicant respectfully traverses and appeals to the Board from the Examiner's rejections of Claim 27, under 35 U.S.C. §103(a), as being un-patentable over KELLY, *et al.* in view of KIKINIS and further in view of PALMER *et al.* as follows.

§ 7.1 Claim 27

39. In the Final Office Action, (i) the Examiners acknowledged certain differences between the claimed invention and KELLY, *et al.*, and stated on page 17 therein, "Kelly *et al.* does not disclose Web content that includes a stream of actuation-control data provided by a web site for controlling body part movement of an Internet-enabled talking doll coupled to and controlled by a computer, the stream of actuation-control data being transmitted from the web site to the computer in synchronization with the broadcasting of a TV program. Kikinis discloses an interactive doll system 11 comprising a doll 13 adapted for bi-directional communication with a PC 15 (col.5, 1.17-19)(Fig. 1). By way of peripheral connection, doll 13 acquires all of the computing and data power of the host. The host has an appropriate telephone modem and Internet operative software, giving the doll access to data routines available on the Internet (col.5, 1.32-34)(col.7, 1.19-24)(col.9, 1.20-25). The doll has controllable moving body parts and speech functions (col.5, 1.56-67 and col.6, 1.1-11)(Fig. 1). Kelley *et al.* modified with Kikinis does not teach that the stream of actuation-control data being transmitted from the web site to the computer be in synchronization with the broadcasting of a TV program. Palmer *et al.* discloses a method and apparatus for connecting a computer to electronic address in sync with an audio/video broadcast (Col.5, 1.22-34). It would have been obvious to anyone of ordinary skill in the art at the time that the invention was made to modify Kelly *et al.* to include an interactive doll system 11 such as that taught by Kikinis and to further modify Kelly *et al.* and Kikinis to include a method and apparatus for connecting a computer to electronic addresses in sync with an audio/video broadcast such as that taught by Palmer *et al.* in order to portray broadcasting related content interactively through a computer controlled doll in sync with television programming (col.2, 1.35-45)."

40. Evidently, the Examiners have made substantial effort to try to modify and combine the references to arrive at the claimed invention, and to not allow any claim regardless of how narrow the claim limitations were drafted. However, Examiners failed to establish *prima facie* case of obviousness because, (i) the Examiner failed to provide any evidence of suggestion or motivation to modify and combine these references as alleged by the Examiners. *Ex parte Clapp, supra; In re Vaeck, supra; In re Lee, supra; In re Kotzabk*; and (ii) The Examiner's rejection is based on the Examiners' conclusory statements without any "concrete evidence" of suggestion or motivation "in the record" *In re Lee, supra. In re Zurko, supra.*

PART VIII. CONCLUSION

41. In Applicant's Arguments / Amendment paper filed 8/12/2005, Applicant advised the Examiners in paragraph 20 therein that, according to MPEP § 2144.03, only in very limited circumstance, it is appropriate for Examiners to rely on the so-called "common knowledge" not in the record in making obvious rejection, in which case (i) the rejection should be **judiciously applied**, and (ii) the Examiners are **required to take official notice** of facts or common knowledge without supporting documentary evidence. However, the Examiners failed to meet such requirements in the Final Office. Applicant also advised the Examiners in the 8/12/2005 filing that, (iii) such **official notice** may only be taken by the Examiners where the facts alleged to be well-known or common knowledge are capable of instant and unquestionable demonstration as being well known; MPEP § 2144.03.A; and (iv) the technical line of reasoning underlying a decision to take such official notice must be clear and unmistakable, and be based on sound technical and scientific reasoning; *In re Soli*, 317 F.2d 941, 945-47 (CCPA 1963); MPEP § 2144.03.B; and (v) If Applicant challenges that the Examiner's factual assertion is not properly noticed or not based upon common knowledge, the Examiner must support the finding with adequate evidence; MPEP § 2144.03.C; See also 37 C.F.R. § 1.104(d)(2). Again, the Examiners failed to meet these requirements in the Final Office Action. Applicant would like to requests again, pursuant to 37 C.F.R. § 1.104(d)(2) and MPEP§2144.03, that (I) the Examiner take official notice of any facts deemed common knowledge or well known, and (II) provide documentary evidence in support thereof.

(Note: 37 C.F.R. § 1.104(d)(2) provides "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.")

42. For the foregoing reasons, Applicant respectfully appeals from the Examiner's rejections of Claims 13-15, 17-30, and 33-34 in the Final Office Action to the Board of Patent Appeals and Interferences. Applicant is aware of the fact that the shortened statutory period for filing the Notice of Appeal as a reply to the Final Office Action dated 10/05/2005 has expired on 01/05/2006. However, Applicant was not able to afford the required appeal-related fees, and was planning to file a petition for an extension of time. The maximum time period for Applicant to file Notice of Appeal is six months from the 10/05/2005 Final Office Action, which is before 4/05/2006. However, Applicant still could not afford the required appeal-related fees and extensions of time fees. The Notice of Appeal has been filed within the maximum period set by the statute without the required fee. The present Appeal Brief is filed within two months from the filing date of the Notice of Appeal, also without the required fees. Applicant will submit all the required fees at an earliest possible time.

PART IX.A. CLAIMS APPENDIX

Claim 13 A handheld remote control device adapted to control a multimedia system including an Internet-enabled client computer executing a web browser application, said web browser including a conventional bookmark function for organizing a listing of URLs that are provided for linking to a user's favorite web pages, said handheld remote control device comprising:

a casing having an exterior surface;

a user input assembly disposed on said exterior surface of said casing; and

a transmitter circuitry situated within said casing and coupled to said user input assembly for generating and transmitting to a selected device of the multimedia system electromagnetic command signals representative of said user's operations of said user input assembly of said remote control device;

said user input assembly including a bookmark key for causing said web browser to add a bookmark linking to a web content identified by a URL to the bookmark URL listing of the browser in response to said user's activation of said bookmark key.

Claim 14 The handheld remote control device as set forth in Claim 13, wherein said multimedia system further comprises a television (TV) subsystem, and wherein said web content identified by said URL is associated with a current TV event received via said TV subsystem.

Claim 15 The handheld remote control device as set forth in Claim 13, wherein said multimedia system further includes a TV subsystem, and wherein said user input assembly of said remote control device further comprises TV-control buttons for providing conventional TV-remote-control operations.

Claim 16 The handheld remote control device as set forth in Claim 13, wherein said user input assembly further comprises a buy button for activating an online identity-authentication and a purchasing applications of said Internet-enabled client computer.

Claim 17 The handheld remote control device as set forth in Claim 13, wherein said web content to be received by the web browser is provided by a web site and is associated with a predetermined segment of a TV program, and wherein transmission of said web content from said web site to said web browser is in synchronization with broadcasting of said predetermined segment of said TV program.

Claim 18 A method of providing interactive content through a multimedia computer executing a web browser application, said method comprising the steps of:

receiving an electromagnetic bookmark signal transmitted from a handheld remote control device in response to a user activating a single bookmark button on said remote control device; and in response thereto,

adding a bookmark linking to a web content identified by a URL to said web browser's bookmark URL listing.

Claim 19 The method as set forth in Claim 18, wherein said web content is associated with a current TV event.

Claim 20 The method as set forth in Claim 18, wherein said web content includes at least one web page for providing information relating to a TV program.

Claim 21 The method as set forth in Claim 18, wherein said web content includes a stream of actuation-control data for controlling body part movement of an Internet-enabled talking doll coupled to and controlled by said multimedia computer.

Claim 22 The method of Claim 18, further comprising the step of, prior to said step of receiving electromagnetic bookmark signal, receiving, through the Internet, said web content from a web site, said web content being transmitted from said web site to said computer in synchronization with broadcasting of a selected segment of a TV program.

Claim 23 The method as set forth in Claim 22, wherein said step of receiving web content comprises the steps of receiving the web content data transmitted from said web site and displaying said web content via said web browser.

Claim 24 In an interactive home entertainment system including a TV subsystem, an Internet-enabled computer system executing a web browser application, and a handheld remote control device for control of any other components of said entertainment system by a user, a computer-implemented method for providing interactive content associated with a current TV event received via said TV subsystem, said method comprising the steps of:

In response to receiving a wireless bookmark signal transmitted from said remote control device, said wireless bookmark signal representative of said user's activation of a single bookmark button on said remote control device,

Requesting a web content associated with said current TV event from a designated web site, and

Receiving said web content associated with said current TV event from said designated web site.

Claim 25 The method as set forth in Claim 24, wherein said step of receiving said web content comprises the step of receiving data file or data stream of said web content from said designated web site.

Claim 26 The method as set forth in Claim 25, wherein said web content includes at least one web page for providing information relating to said TV event, and wherein said step of receiving said web content further comprises the step of displaying said at least one web page via said web browser.

Claim 27 A method as set forth in Claim 24, wherein said web content includes a stream of actuation-control data provided by said web site for controlling body part movement of an Internet-enabled talking doll coupled to and controlled by the computer, said stream of actuation-control data being transmitted from the web site to the computer in synchronization with the broadcasting of said TV event.

Claim 28 The method as set forth in Claim 24, wherein said step of requesting web content comprises the step of sending a request, via the Internet, to said web site for requesting from said web site said web content associated with said current TV event.

Claim 29 The method as set forth in Claim 28, wherein said step of requesting web content further comprises the step of, prior to said step of sending request, retrieving URL associated with said web content through the Internet.

Claim 30 The method of Claim 24, further comprising the step of, adding a bookmark linking to said web content identified by a URL to said web browser's bookmark URL listing.

Claim 33 The handheld remote control device as set forth in Claim 13, wherein said web content identified by said URL is a web page displayed on a display of said multimedia system.

Claim 34 The method as set forth in Claim 18, wherein said web content identified by said URL is a web page displayed on a display of said multimedia system.

PART IX.B. EVIDENCE APPENDIX

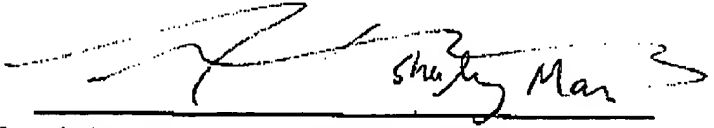
none

PART IX.C. RELATED PROCEEDINGS APPENDIX

none

Respectfully Submitted

SIGNED ON: 04/10/2006


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